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Petition to
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Director's
decision

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION TO THE COMMISSIONER

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In re Serial No:	06/787,692
Filed:	10/15/85
Applicant:	Ole K. Nilssen
Group Art Unit:	212
Examiner:	WILLIAM H. BEHA
Group Director:	GERALD GOLDBERG

I, OLE K. NILSSEN, HEREWITH CERTIFY THAT THE DATE OF DEPOSIT WITH THE U.S. POSTAL SERVICE OF THIS PAPER OR FEE IS: 2-30-88

PETITIONER: Ole K. Nilssen
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Barrington, Illinois 60010

Telephone: 312-658-5615

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Under 37 C.F.R. 1.181(a), the above named Petitioner (hereinafter "Applicant") herewith petitions Commissioner to instruct the above-named Examiner and Director to rescind the decision expressed in their letter dated 01/21/88 and to enter in the file for the above-identified application the Appeal Brief originally submitted by Applicant.

A copy of Applicant's Appeal Brief is enclosed as is also a copy of Examiner's communication relative to that Appeal Brief.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Ole K. Nilssen
Entitled:	INVERTER CIRCUITS
Serial Number:	06/787,692
Filing Date:	10/15/85
Art Unit:	212
Examiner:	WILLIAM H. BEHA

I, OLE K. NILSSEN, HEREWITH CERTIFY THAT THE DATE OF DEPOSIT WITH THE U.S. POSTAL SERVICE OF THIS PAPER OR FEE IS: 12-26-87

APPEAL BRIEF

88-3439

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Pursuant to Notice of Appeal, Applicant herewith provides a Brief in accordance with 37 U.S.C. 1.192.

The $65.00 fee for instant Appeal Brief was paid (Check #1089) in connection with as-yet-unprocessed Appeal Brief submitted on 09/04/86.

Moreover, the $65.00 fee for the Notice of Appeal submitted 10/27/87 was inadvertently paid twice: once with Check #1087 accompanying a first Notice of Appeal submitted on 09/02/86, and once with Check #2487 accompanying a second Notice of Appeal submitted on 10/27/87. Thus, one of these fees should be refunded.

At issue is the propriety of Examiner's rejection of claims 143 and 144 under 35 U.S.C. 103 as being unpatentable over Walker and Pintell.

PRO SE APPLICANT

Subject application and appeal are being prosecuted by Applicant without the benefit of counsel.

CONCISE EXPLANATION OF INVENTION

The invention is consisely described by claim 143, as follows.

143. The combination of:

rectifier means (27/28/29/31) connected with an ordinary electric utility power line and operative to provide a DC voltage across a set of DC terminals (38/39);

inverter means (24) having control input means (bases of transistors 42/43), the inverter means being connected with the DC terminals and operative to provide a substantially squarewave voltage across a pair of squarewave output terminals (conductor 37 and junction 44) in response to a drive signal being provided to the control input means;

an L-C series-circuit having a tank-capacitor (52) and a tank-inductor (51), and being effectively connected across the squarewave output terminals;

load means (26) effectively connected in parallel with the tank-capacitor; and

feedback means (47/49) connected in circuit between the squarewave output terminals and the control input means, the feedback means: i) comprising saturable inductor means (53/54) effectively connected with the control input means, and ii) being operative to provide the drive signal; thereby to cause the inverter to self-oscillate at a frequency equal to or higher than the natural resonance frequency of the L-C series-circuit;

whereby: i) most of the real power provided from the squarewave output terminals flows into the load means, and ii) the saturable inductor means and the L-C series-circuit are co-determinative of the frequency of self-oscillation.

AUTHORITIES

Applicant wishes to rely on the authority of sound reasoning as well as on those authorities identified in the attached copy of a write-up entitled AUTHORITIES.

ARGUMENTS IN SUPPORT OF ALLOWABILITY

Examiner rejected claims 143 and 144 under 35 U.S.C. 103 as being unpatentable over Walker in view of Pintell or, alternatively, vice versa.

Applicant traverses these rejections for the following reasons.

(a) Examiner asserts that:

"it would have been obvious to use Pintell's inverter of figure 6 in the generally disclosed square wave oscillator configuration shown on the front page of Walker".

In view of Authority #8, Examiner seems to be misinterpreting the law by "equating that which is within the capabilities of the skilled designer with obviousness".

In particular, Examiner has provided no evidence to the effect that there existed an obvious advantage in combining Pintell with Walker (or vice versa) in such exact manner as to attain the claimed invention as specifically defined.

What might this obvious advantage be?

Clearly, without expected advantage, no motivation could possibly exist.

Equally clearly, absent expected advantage, Examiner's proposed combination must be viewed as arbitrary: concocted for the purpose of attaining the claimed invention, not because it leads to an obvious advantage.

In other words, starting with Walker -- who already teaches apparently adequate means to provide a sinusoidal output voltage to a load parallel-connected with an L-C circuit -- what obvious advantage would be expected from incorporating the teachings of Pintell in such exact manner as to arrive at the claimed invention as it is specifically defined?

Or, starting with Pintell -- who already teaches apparently adequate means to provide a sinusoidal current to a load series-connected with the an L-C circuit -- what obvious advantage would be expected from incorporating the teachings of Walker in such exact manner as to arrive at the claimed invention as it is specifically defined?

In other words, what might be the plain and clear rationale of a person of ordinary skill in the relevant art for selecting -- from among the tens of thousands of references associated with this art, all of which presumably present in his mind's library -- Pintell to combine with Walker or, conversely, Walker to combine with Pintell in such exact manner as to attain the claimed invention as specifically defined?

(b) Examiner then makes the following two statements:

(1) "Where a sinusoidal load voltage is required, it would have been obvious to connect the load across capacitor C as in Walker"; and

(2) "Where a sinusoidal current was desired through the load, it would have been obvious to connect it as in Pintell".

Assuming, for sake of argument, that those statements were true, in what way do they constitute evidence of obviousness with respect to combining the two references?

In fact, the two statements would rather seem to lead to the following conclusion:

(x) where a sinusoidal load voltage be desired, Walker's arrangement would seem appropriate; but

(y) where a sinusoidal load current be desired, Pintell's circuit would seem appropriate.

Hence, Examiner has not proven that there existed obvious motivation for combining the two references, let alone combining them in such exact manner as to attain the claimed invention as it is specifically defined.

CONCLUDING REMARKS

By way of his office actions, Examiner has led Applicant to believe that Examiner may not posses ordinary skill in the art to which the claimed invention belongs; which means that Examiner may not posses adequate skills to properly examine instant application.

Applicant herewith makes an official allegation to the effect that Examiner does not posses ordinary skill in the art relevant to the proper examination of this application.

Clearly, without possessing ordinary skill in the art to which a given subject matter belongs, it is meaningless -- with respect to that given subject matter -- for a person to render judgements in respect to: i) what is obvious and what is unobvious to a person who does have ordinary skill in this subject matter, ii) what is usual and what is unusual, iii) what is common practice and what is not, iv) what is safe practice and what is not, v) what is feasible to do and what is not, vi) what is practicable and what is not, vii) what works and what

does not, viii) what kinds of circuits and/or elements are combinable and what kinds are not, ix) how circuits function and how they do not function, x) what may be regarded as prima facie so versus prima facie not so; xi) what are common perceptions, understandings, attitudes, prejudices, etc.; xii) how to properly interpret and apply facts and circumstances; xiii) what types of circuit modifications are feasible versus what types are not; xiv) what kinds of circuit changes are apt to be problematic versus what kinds are not; xv) what constitutes appropriate and/or feasible expedients in a given circuit, arrangement or situation versus what does not; xvi) etc.

Hence, if Examiner does not possess ordinary skill in the art relevant to the examination of instant application, he is simply not qualified to render judgements relative to what is obvious and/or what is unobvious.

Similarly, if Examiner does not posses ordinary skill in the art to which instant subject matter belongs, he is not in the position of carrying on an intelligent discussion in respect to that subject matter. As a net result, it becomes a totally unreasonable burden for Applicant to try to educate Examiner to a degree sufficient to permit Examiner to deal intelligently and knowledgably with such subject matter.

For instance, in the last paragraph of page 2 of his Amendment D (dated 07/04/87), Applicant makes the following statement:

"there is very little that is obvious in terms of changing inverter topography between a series-excited/series-loaded L-C inverter circuit (such as that of Pintell) and a series-excited/ parallel-loaded L-C inverter circuit (such as that of Walker or Applicant)".

This statement refers to a situation which is well known to a person possessing ordinary skill in the art of inverters loaded by tuned L-C circuits, especially so in respect to series-excited/parallel-loaded L-C inverter circuits; and, except if Examiner possesses at least that ordinary degree of skill, Examiner is simply not competent to render judgement relative to what is versus what is not appropriate and/or workable with respect to such L-C loaded inverter arrangements.

Except if Examiner were to provide credible evidence to the effect that he does possess ordinary skill in the art relevant to the proper examination of this application and its claimed subject matter, Applicant will proceed in the prosecution on the basis that Examiner has acknowledged Applicant's allegation to the effect that Examiner does not possess ordinary skill in the art relevant to the proper examination of this application and the subject matter claimed therein.

Even though Applicant believes that it ought to be entirely unnecessary, if absolutely required in order to attain allowance of the disputed claims, he is willing -- in spite of the substantial amounts of time, effort and cost involved -- to provide expert testimony to the effect of verifying and/or substantiating the correctness of any or all of the various allegations of facts made by Applicant in this Appeal Brief.

Clearly, in view of the applied references and the arguments presented above, Examiner erred in not allowing the claims at issue.

If the Examiners in Chief should disagree with Applicant in respect to the allowability of the claims at issue, they are requested to call Applicant on the telephone, thereby to attempt to clarify and/or resolve any remaining issues; thereby, in turn, to attempt to avoid -- both for the taxpayers generally as well as for Applicant -- the substantial costs associated with an appeal to the CAFC.

Ole K. Nilssen Pro Se Applicant

312-658-5615

Date: 12-10-87

CLAIMS

143. The combination of:

rectifier means connected with an ordinary electric utility power line and operative to provide a DC voltage across a set of DC terminals;

inverter means having control input means, the inverter means being connected with the DC terminals and operative to provide a substantially squarewave voltage across a pair of squarewave output terminals in response to a drive signal being provided to the control input means;

an L-C series-circuit having a tank-capacitor and a tank-inductor, and being effectively connected across the squarewave output terminals;

load means effectively connected in parallel with the tank-capacitor; and

feedback means connected in circuit between the squarewave output terminals and the control input means, the feedback means: i) comprising saturable inductor means effectively connected with the control input means, and ii) being operative to provide the drive signal; thereby to cause the inverter to self-oscillate at a frequency equal to or higher than the natural resonance frequency of the L-C series-circuit;

whereby: i) most of the real power provided from the squarewave output terminals flows into the load means, and ii) the saturable inductor means and the L-C series-circuit are co-determinative of the frequency of self-oscillation.

144. The combination of:

rectifier means connected with an ordinary electric utility power line and operative to provide a DC voltage across a set of DC terminals;

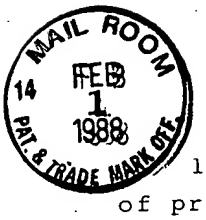
inverter means comprising a first and a second transistor connected in circuit with the DC terminals, each transistor having a control input, the transistors being operative, in response to drive signals provided at their control inputs, to alternatingly conduct, thereby to cause the inverter means to provide a substantially squarewave voltage across a pair of squarewave output terminals;

an L-C series-circuit having a tank-capacitor and a tank-inductor, and being effectively connected across the squarewave output terminals;

load means effectively connected in parallel with the tank-capacitor; and

feedback means connected in circuit between the squarewave output terminals and the control inputs, the feedback means comprising saturable inductor means and being operative to provide the drive signals, thereby to cause the inverter to self-oscillate at a frequency equal to or higher than the natural resonance frequency of the L-C series-circuit;

whereby: i) most of the real power provided from the squarewave output terminals flows to the load means; and ii) the saturable inductor means and the L-C series-circuit jointly determine the frequency of self-oscillation.



AUTHORITIES

1. "patentable invention may lie in discovery of source of problem even though remedy may be obvious once source of problem is identified" (In re Sponnoble, 405 F.2d 578, 160 USPQ 237, 1969);

2. "A patentable invention within the ambit of 35 U.S.C. 103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the result inherent in their use" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243, 1969);

3. "Where unobvious aspect of invention resides in recognition of source of problem, Patent Office inquiries should be directed, in part at least, to question of whether such a recognition would have been obvious to one of ordinary skill in the art; inquiry must go beyond the nature of the solution" (In re Roberts, 470 F.2d 1399, 176 USPQ 313, 1973);

4. "we also believe that a more proper, albeit not exclusive, inquiry in a case such as this is to look further as to the reasons for making the combination" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243, 1969);

5. "If there is no evidence that a person of ordinary skill in the art at time of applicant's invention would have expected problem to exist at all, it is not proper to conclude that invention which solves this problem, which is claimed as an improvement of prior art device, would have been obvious to that hypothetical person". (In re Nomiya, 184 USPQ 608, 1975)

6. "There must be a reason apparent at time invention was made to person of ordinary skill in the art for applying the teaching at hand, or use of teaching as evidence of obviousness will entail prohibited hindsight". (In re Nomiya, 184 USPQ 608, 1975)

7. In Geiger v. PTO (Appeal No. 86-1103 at the CAFC) the CAFC stated that: i) obviousness "can not be establsihed by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination", and ii) "one skilled in the art might find it obvious to try various combinations ... However, this is not the standard of 35 U.S.C. 103".

#8. In re Sung Nam Cho (Appeal No. 86-973 at the PTO) the Board of Appeals concluded that the examiner had misstated the law by "equating that which is within the capabilities of the skilled designer with obviousness".

#9. In Richdel, Inc. v. Sunspool Corp. (714 F.2d 1573 -- Fed Cir. 1983), Chief Judge Markey presented a detailed rejection of the doctrine of combination patents: "It was error for the district court to derogate the likelihood of finding patentable invention in a combination of old elements. No species of invention is more suspect as a matter of law than any other. Attempted categorization for the purpose of determining various "rules" detracts from what should be the sole question: whether the claimed invention would have been obvious within the meaning of paragraph 103. Most, if not all, inventions are combinations and mostly of old elements".

#10. In Adams (356 F.2d 998 -- CCPA 1966), the Board (of Appeals) was reversed because "neither reference contains the slightest suggestion to use what it discloses in combination with what is disclosed in the other." (356 F.2d at 1002)

#11. In Imperato (486 F.2d 585 -- CCPA 1973): although combining the references' teachings yielded the result claimed, the CCPA held that the combination was not obvious "unless the art also contains something to suggest the desirability of the combination".

#12. In Sernaker (702 F.2d at 995-96), the CAFC interpreted Imperato to mean that "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings".

#13. In Environmental Design (713 F.2d at 698), the CAFC stated: "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant" [to obviousness].

#14. In Fromson v. Advance Offset Plate (755 F.2d 1556), the CACF stated as follows. (Underlining by Applicant)

"Where, as here, nothing of record plainly indicates that it would have been obvious to combine previously separate process steps into one process, it is legal error to conclude that a claim to that process in invalid under paragraph 103."

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

In re application of
Ole K. Nilssen
Serial No. 06/787,692
Filed: October 15, 1985
For: INVERTER WITH RESONANT L-C CIRCUIT

Returned herewith is appellant's Appeal Brief filed December 28, 1987 in Patent Application, Serial No. 787,692. The brief is returned to appellant under 37 CFR 1.3 for his failure to conduct business with the U. S. Patent and Trademark Office with decorum and courtesy.

This is not the first instance of applicant's failure to conduct business with decorum and courtesy in this case. See, for example, the letter returning earlier papers, mailed March 26, 1986.

Applicant is advised that the subject matter disparaging the examiner's skill (Brief, pages 4-6) is as out of place in this brief as it was in the earlier returned papers.

Moreover, the brief should be limited to addressing the grounds of rejection stated by the examiner. Allegations of a personal nature of the type included in the concluding remarks, accompanied with a challenge to the Examiner to provide credible evidence of competency at this stage of the prosecution, have no place in a brief.

The period for filing a brief continues to run from the filing date of the Notice of Appeal, that is, November 30, 1987.

William H. Beha
Senior Examiner
Art Unit 212

CONCUR: Gerald Goldberg
Director, Group 210

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